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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,476	10/08/2003	Ron Hyman Rothman	002566-020000	7476

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EXAMINER	
FABER, DAVID	

ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/681,476	ROTHMAN ET AL.	
	Examiner	Art Unit	
	DAVID FABER	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to amendment filed on 16 June 2008.

This Office Action is made Final.

2. Claims 1, 9, 17, 18, 19, 26, 33, 34, 35, 43, 51, and 42 have been amended.

3. The objection of the drawings has been withdrawn as necessitated by the amendment. The rejection of Claims 1-8, and 19-25 under 35 U.S.C. 112, second paragraph, has been withdrawn as necessitated by the amendment. The rejection of Claims 17, 33, and 51 under 35 U.S.C. 112, sixth paragraph, has been withdrawn as necessitated by the amendment. The rejection of Claims 1-8, under 35 U.S.C. 101, has been withdrawn as necessitated by the amendment. The rejection of Claims 1-5, 9-13, 17-22, 26-29, 33-39, 43-47, and 51-52 under 35 U.S.C. 102(b) as being anticipated by Landsman et al (US Patent 6,317,761, published 11/13/2001) has been withdrawn as necessitated by the amendment.

4. Claims 1-52 are pending. Claims 1, 9, 17, 18, 19, 26, 33, 34, 35, 43, 51, and 52 are independent claims.

Drawings

5. The drawings were received on 8 October 2003. These drawings are now accepted.

Specification

6. The specification is objected to as failing to provide proper antecedent basis for

the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The phrases "memory" and "computer readable storage medium" are not found to have proper antecedent basis in the specification; however it is necessary to use this terminology in order to properly define the claim within the boundaries of statutory subject matter. In order to overcome the object, an amendment to the specification is necessary constituting a non-exhaustive statement of what the phrases "memory" and "computer readable storage medium" would be as it would have been known to one of ordinary skill in the art at the time of the invention, in order to verify that the terms "memory" and "computer readable storage medium" could not be taken in the context of non-statutory subject matter.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 17, 18, 19-25, 33-34, and 51-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For your reference, below is a section from MPEP 2106 :

> (a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se
> Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other

> claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.
> Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.
> Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.
> **Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.**

9. Claims 17, 18, 19-25, 33-34, and 51-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims appear to be claiming "software systems" i.e. systems without hardware indication, which is a computer program per se. Since the claims disclose computer program per se that is not embodied on a computer readable medium, they appear non-statutory.

Claim Rejections – 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-5, 9-13, 17-22, 26-29, 33-39, 43-47, and 51-52 rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (US Patent 6,317,761, published 11/13/2001).

As per independent claim 1, Landsman et al discloses a system/method comprising:

- receiving a creative definition; (Column 3, lines 45-61; Column 17, lines 37-52)
- determining if the creative definition is a programmable or non-programmable creative definition; (Column 3, lines 45-61; Column 17, lines 37-52: Browser has the ability to determine if the embedded code is a banner or is a javascript program)
- assembling, if the creative definition is a non-programmable creative, the non-programmable creative; and (Column 3, lines 45-61: Discloses obtaining the graphic to be rendered)
- executing, if the creative definition is a programmable creative, the programmable creative definition to generate the creative. (Column 17, lines

37- Col 20, line 17: Discloses reading the advertising tag and executing the JavaScript code associated with the advertisement)

However, Landsman et al fails to disclose performing the limitations on the server-side system. On the other hand, Landsman discloses a client/server architecture in a networked environment (Col 15, lines 48-51) wherein the server can be a separate software application which executes on any computer in the networked environment. (Column 15, lines 61-64) Therefore, It was well-known to one of ordinary skilled in the art at the time of Applicant's invention that the functionality of a client/server architecture is applicable and interchangeable between a client and a server since there is no real significant differences between the processing abilities of a client and a server. In addition, one of ordinary skill in the art would not see any reason why certain data processing techniques, once taught, cannot or should not be applied to either the client or server side of a system. Each side contains a data processing unit and techniques for one processing unit may very well be applicable to other data processing units; therefore, a program tailored to be executed on a client can also be executed on a server.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modified Landsman's method to perform on a server since it would have provided the benefit of taking advantage of server capabilities of management and distribution duties with other clients that a server provides to a client.

As per dependent claim 2, Landsman et al discloses wherein the step of executing the programmable creative definition to generate the creative includes the step of periodically executing the programmable creative definition responsive to a request generated by an advertising system. (Col 17, lines 7-21, Column 18, lines 38-49: Discloses the advertising system generating a request to download the advertisement based on the URL provided, wherein an applet is then executed to download the advertisement)

As per dependent claim 3, Landsman et al discloses wherein the step of executing the programmable creative definition to generate the creative includes the step of retrieving, responsive to the 20 programmable creative definition, data from the server-side system. (Col 16, line 53 – Col 17, line 21)

As per dependent claim 4, Landsman et al discloses wherein the data is proprietary data. (Column 21, lines 46-60: Discloses data being streamed proprietary, thus the data being proprietary data)

As per dependent claim 5, Landsman et al discloses including the step of transmitting the creative to a web server for transmission to an end-user. (i.e. Col 16, line 53- Col 17, line 21: Advertisement is downloaded from the server to the client)

As per independent claim 9, Claim 9 recites similar limitations as in Claim 1 and is rejected under similar rationale. Furthermore, Landsman et al discloses a processor and memory. (Column 39, lines 39-45)

As per dependent claim 10, Claim 10 recites similar limitations as in Claim 2 and is rejected under similar rationale.

As per dependent claim 11, Claim 11 recites similar limitations as in Claim 3 and is rejected under similar rationale.

As per dependent claim 12, Claim 12 recites similar limitations as in Claim 4 and is rejected under similar rationale.

As per dependent claim 13, Claim 13 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 17, Claim 17 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per independent claim 18, Claim 18 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per independent claim 19, Landsman et al discloses a method compromising:

- storing a first definition for a non-programmable creative; (Column 3, lines 45-61: Discloses embedding HTML code in a web page to generate a banner)
- storing a second definition for a programmable creative including a program for generating the programmable creative; (Column 17, lines 37-52: Discloses embedding a special HTML advertising tag that contains a URL to a Javascript program)
- executing the first definition to generate a non-programmable creative; storing the non-programmable creative; (Column 3, lines 45-61: When the HTML code is interpreted by the client's browser, it fetches and downloads the banner to the client's browser to be rendered to the client. The banner is stored on a server and in the client's browser when retrieved)

- executing the second definition to generate a programmable creative; storing the programmable creative (Column 17, lines 37- Col 20, line 17: Discloses reading the advertising tag and executing the JavaScript code associated with the advertisement, wherein the advertisement is stored at the server, or at the client's browser)
- receiving a request to transmit a creative to a viewer; selecting, by an advertising system responsive to the request, the programmable creative or the non-programmable creative; and transmitting the selected programmable creative or non-programmable creative to the viewer. Column 17, lines 37- Col 20, line 17: Discloses reading the advertising tag, executing the JavaScript code associated with the advertisement ,generating a request to download the advertisement based on the URL provided, wherein an applet is then executed to download the advertisement which the advertisement is downloaded from the server to the client)

As per dependent claim 20, Landsman et al discloses the step of executing the second definition to generate a programmable creative includes the step of periodically executing the second definition to generate an updated programmable creative. (Col 20, lines 24-28; 40-49; 15-42)

As per dependent claim 21, Claim 21 recites similar limitations as in Claim 3 and is rejected under similar rationale.

As per dependent claim 22, Claim 22 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 26, Claim 26 recites similar limitations as in Claim 19 and is rejected under similar rationale. Furthermore, Landsman et al discloses a processor and memory. (Column 39, lines 39-45)

As per dependent claim 27, Claim 27 recites similar limitations as in Claim 20 and is rejected under similar rationale.

As per dependent claim 28, Claim 28 recites similar limitations as in Claim 3 and is rejected under similar rationale.

As per dependent claim 29, Claim 29 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 33, Claim 33 recites similar limitations as in Claim 19 and is rejected under similar rationale.

As per independent claim 34, Claim 34 recites similar limitations as in Claim 19 and is rejected under similar rationale.

As per independent claim 35, Claim 35 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per dependent claim 36, Claim 36 recites similar limitations as in Claim 2 and is rejected under similar rationale.

As per dependent claim 37, Claim 37 recites similar limitations as in Claim 3 and is rejected under similar rationale.

As per dependent claim 38, Claim 38 recites similar limitations as in Claim 4 and is rejected under similar rationale.

As per dependent claim 39, Claim 39 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 43, Claim 43 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per dependent claim 44, Claim 44 recites similar limitations as in Claim 2 and is rejected under similar rationale.

As per dependent claim 45, Claim 45 recites similar limitations as in Claim 3 and is rejected under similar rationale.

As per dependent claim 46, Claim 46 recites similar limitations as in Claim 4 and is rejected under similar rationale.

As per dependent claim 47, Claim 47 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 51, Claim 51 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per independent claim 52, Claim 52 recites similar limitations as in Claim 1 and is rejected under similar rationale.

12. Claims 6-8, 14-16, 23-25, 30-32, 40-42, and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (US Patent 6,317,761, published 11/13/2001) in further view of Galomb (US PGPub 20010039510, published 11/8/2001)

As per dependent claims 6-8, Landsman et al discloses the ability for an advertiser to change or update any of its advertisements by just modifying appriopate

media and AdDescriptor files that reside in the third-party advertising management system. (Column 13, lines 55-66) However, Landsman et al fail to specifically disclose periodically changing text, an image, or a hyperlink within the creative. However, Galomb discloses advertisement includes text, images, and/or hyperlinks. (Paragraph 0004) Thus, in conjunction of Landsman et al with Galcomb, an advertiser would have the ability to change its advertisements by modifying the text, image or hyperlink associated with the advertisement.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modify Landsman et al with Galomb's advertising system to enable since it would have provided the benefit of the need for advertisers to directly and instantly control the testing and optimizing of their advertisements.

As per dependent claims 14-16, Claims 14-16 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

As per dependent claims 23-25, Claims 23-25 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

As per dependent claims 30-32, Claims 30-32 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

As per dependent claims 40-42, Claims 40-42 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

As per dependent claims 48-50, Claims 48-50 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

Response to Arguments

13. Applicant's arguments with respect to claims 1-52 have been considered but are moot in view of the new ground(s) of rejection.

Arguments addressing in regards of the new limitations of Claims 1-52 brought forth in the amendment of the limitations performing on the server-side system has been viewed the new ground of rejection of 35 USC 103(a) under new references using Landsman et al.

14. Applicant's arguments filed 16 June 2008 have been fully considered but they are not persuasive.

15. On page 16, in regards to Applicant's argument of claims 17-25, 33-34, and 51-52 are rejected under 35 USC 101, Applicant argues the claims therefore comply with the statutory subject matter requirement. However, the Examiner disagrees. For claims 17-25, 33-34, and 51-52, the specification failed to specifically disclose or mention the term “computer readable storage medium” or what a computer readable storage medium comprises at all; (i.e. memory, hard drive) thus, the claims are viewed as software in view of data structures. Furthermore, the claim language in the claims failed to disclose or mention what is included a system at all; thus, the claims are viewed as software in view of data structures. The use of the word "system" does not inherently mean that claim is directed to a physical machine. Therefore, the claims, themselves, lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a

process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory. They are, at best, functional descriptive material per se. Thus, in regards to claims 1-8, 17-25, 33-34, and 51-52, the claims, as written, appear to be claiming "software systems" i.e. systems without hardware indication, which is computer program per se. The claims as written do not recite any hardware indication, therefore, viewed as "software systems".

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Faber/
Examiner, Art Unit 2178

	/CESAR B PAULA/ Primary Examiner, Art Unit 2178